



RECEIVED
OCT 28 2003 #28
TC 1700
PATENT

Customer No. 34,986
Attorney Docket No. 01222.0034-01-000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE...
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
David A. RUSSO et al.)
Application No.: 09/287,664) Group Art Unit: 1755
Filed: April 7, 1999) Examiner: D. Brunsman
For: COATING COMPOSITION)
FOR GLASS)

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
Sir:

APPELLANTS' REPLY BRIEF PURSUANT TO 37 C.F.R. § 1.193 (b)

Appellants submit the following reply brief in triplicate pursuant to 37 C.F.R. § 1.193 (b) to respond to the Examiner's Answer of August 18, 2003.

THE PROSECUTION OF THE REISSUE PATENT

The appellant's brief on appeal refers to the Russo et al. patent, U. S. 5,401,305 as the reissue patent and this reply brief will identify it in that way as well. Appellants filed the present application to add reissue claims to the Russo et al. patent as permitted by 35 U.S.C. § 251. The Examiner has rejected these claims on prior art under 35 U.S.C. § 103 (a) as well as on the grounds that appellants have attempted to "recapture" subject matter given up in the reissue patent in order to obtain its allowance.

Appellants will address the "recapture" rejection first. The prosecution history of the reissue patent, summarized as follows, clearly and unequivocally supports their position that the present claims do not include or "recapture" any subject matter given up in the reissue patent in order to obtain its allowance.

Claim 1 of the reissue patent, prior to amendment, claimed a composition, gaseous at temperatures below about 200° C. and atmospheric pressure, that included a tin oxide precursor, a silicon oxide precursor and accelerants selected from organic phosphites, organic borates, and water and mixtures thereof, and a source of oxygen. The presence of the accelerants increased the rate of deposition (reissue patent, col. 4, lines 31-33). The claim also provided that the composition deposit the tin oxide and silicon oxide as a first layer onto glass at rates greater than about 350 Å/sec.

The examiner, in the first office action dated September 20, 1994, rejected all of the claims under 35 U.S.C. § 112 first paragraph, but indicated he would allow claim 1 inter alia if appellants would amend the claim to include all of the limitations of original claim 11 which defined the silicon oxide precursor as a compound having the formula $R_mO_nSi_p$.¹ The examiner did not reject the claims on prior art under 35 U.S.C. § 102 or 35 U.S.C. § 103 or any other grounds. Importantly, the examiner did not reject the tin oxide precursor of claim 1 as originally filed nor the organic phosphites and organic borates claimed as accelerants. In fact, appellants when responding to the Office Action on October 25, 1994 in addition to amending claim 1 to include the $R_mO_nSi_p$ definition of the silicon oxide precursor set out in claim 11, also amended other claims

1. Claim 1, as amended defined m as 3 to 8, n as 1 to 4, and R as independently chosen from hydrogen and acyl, straight, cyclic, or branched-chain alkyl and substituted alkyl or alkenyl, of from one to about six carbon atoms, and phenyl or substituted phenyl.

to redefine the tin oxide precursors and the organic phosphite and organic borate accelerants, even though not called for by the examiner.

Specifically, they amended claim 6 by deleting the definition of the accelerant as triethyl phosphite, and broadening it to organic phosphites and borates having the formulas $(R''O)_3P$ and $(R''O)_3B$,² and adding claim 27 to define inter alia the tin oxide precursor as a compound of the formula R_nSnX_{4-n} .³ The examiner neither called for these amendments nor did he reject the claims that now included them, but instead issued a notice of allowance in his next office action of November 14, 1994.

In the reissue patent, the original claims as well as the amended claims only claimed the composition. It never claimed the invention as now which comprises a process for forming an oxide by oxidizing a gaseous composition comprising at least one precursor of a metal oxide and an accelerant, or that process which also includes a precursor of a silicon oxide. The disclosure always supported this aspect of the invention by noting the "invention. . . [relates to] producing an improved coating on glass, wherein the coated glass exhibits specific properties such as, e.g., controlled refractive index, abrasion resistance, color enhancement, low emissivity, selective light filtration, and anti-iridescence on flat glass substrates." (Reissue patent col. 4, lines 13-18) (emphasis added).

The examiner has indicated his agreement that the written description supports claims to the process by allowing process claims 1-27 in this application.

2. R" is independently chosen from straight, cyclic, or branched-chain alkyl or alkenyl or from one of EtO_2C- , CH_3CO- , or $HOOC-$.

3. R is a straight, cyclic or branched-chain alkyl or alkenyl of from one to about six carbon atoms, phenyl, substituted phenyl, $R'CH_2$, where R' is MeO_2C- , EtO_2C- , CH_3CO- , HO_2C- , X is selected from the group consisting of halogen, acetate, perfluoroacetate,

In the present application the process claims, as compared to the reissue patent composition claims, broaden the tin oxide precursor definition to metal oxide precursors and also broaden the definition of the accelerants. Dependent claim 30 claims the process as further comprising a precursor for a silicon oxide.

THE ISSUES ON APPEAL

The Examiner basically contends that all claims in the reissue application have to include the parameters of composition claim 1 as amended in the reissue patent, i.e., the silicon oxide precursor $R_mO_nSi_p$, the accelerants selected from organic phosphites, organic borates, and water, and only tin oxide precursors, and any broadening of these parameters would recapture subject matter appellants gave up during prosecution of the reissue patent.

Appellants take the position they have the right to broaden their claims in the reissue application to include process claims, since appellants neither presented any process claims in the prosecution of the reissue patent nor any process claims that did not contain the silicon oxide precursor nor the broad array of accelerants, nor the metal oxide precursors.⁴ Accordingly, the examiner never rejected any of these process claims, and the appellants never amended or cancelled these or similar process claims to obtain allowance. It was not possible since these claims never appeared in the reissue patent. The examiner only rejected the silicon oxide precursor in the

and their mixtures, and where n is 0, 1 or 2.

4. The examiner notes at page 5, last sentence of the Examiner's Answer that appellants broadened the claims of the reissue application. Although generally correct appellants emphasize they broadened the reissue by adding subject matter previously unclaimed, namely process claims, whereas the reissue patent never contained any process claims.

composition claims of the reissue patent, and did not reject or address the accelerants or the tin oxide precursor of those composition claims. Appellants mindful of the recapture doctrine filed reissue claims to the previously unclaimed process, but did not confine those claims to the tin oxide precursor, but rather broadened this parameter to include "metal oxides." They also broadened the definition of the accelerants. Bearing in mind that the reissue patent only claimed compositions, appellant filed additional broadening claims in the reissue application to a different class of invention, viz., a "process." that did not limit the scope of coverage to the silicon oxide precursor $R_mO_nSi_p$, the tin oxide precursor or the accelerants of the composition claims of the reissue patent. The examiner remained adamant during the prosecution of the present application that appellants could not broaden the claims in this way.

THE REISSUE STATUTE AND APPLICABLE CASE LAW

The reissue statute ⁵ gives a patentee the right to reissue a defective patent which "is, through error, without any deceptive intention, deemed wholly or partly inoperative or invalid. . . by reason of the patentee claiming. . . less than he had a right to claim in the patent. . . " and to "enlarge the scope of the claims of the original patent. . . [if] applied for within two years from the grant of the original patent." (Emphasis added). In the present application, there is no issue of error without deceptive intent ⁶ or whether the present application was filed within the two year period

5. 35 U.S.C. § 251

6. "[T]he CCPA [Court of Customs and Patent Appeals] stated that error is established where there is no evidence that the appellant intentionally omitted or abandoned the claimed subject matter. Thus the CCPA has construed the term error under section 251 broadly." Ball Corporation v. United States, 729 F. 2d 1429, 221 USPQ 289, 294 (citations omitted). Here, the examiner has neither asserted, nor

to enlarge the scope of the original patent. The appellants claim they have a right to enlarge the scope of the original patent, whereas the examiner takes the position they do not on the grounds that the appellants have tried to recapture subject matter they gave up in order to gain allowance of the patent.

The Court of Appeals for the Federal Circuit and its predecessor court, the Court of Customs and Patent Appeals have developed case law to interpret the reissue concept in order to resolve issues the statute does not address directly. In doing so they found, “[t]he statute [35 U.S.C.] 251] is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally.” In re Weiler, 790 F.2d 1576, 1579, 229 USPQ 673, 675 (Fed. Cir. 1986). See also, Ex parte Daniel M. Eggert and Frank Mikic (deceased) (Precedential Opinion)(Appeal No. 2001-0790), (Bd. of Pat. App. And Intf., Decided May 29, 2003) Slip Opinion, pp. 18-19. “Error under the reissue statute [,however,] does not include a deliberate decision to surrender specific subject matter in order to overcome prior art. . . .” Mentor v. Coloplast Inc., 998 F. 2d 992, 996, 27 USPQ 2d 1521, 1525 (Fed.Cir. 1993). This is known as “[t]he recapture rule. . . [which] prevents a patentee from regaining through reissue the subject matter which he surrendered in an effort to obtain allowance of the original claims.” In re Clement, 131 F. 3d 1464, 45 USPQ 2d 1161, 1163 (Fed. Cir. 1997). “The recapture rule. . . is based on equitable principles.” Ball, 221 USPQ at 296. Bearing in mind that “[r]eissue is remedial in nature and is based on fundamental principles of equity and fairness. . . [t]he recapture rule is inherently founded on similar considerations of equity, providing guidance in the application of the law governing reissue.” Ball, 221 USPQ at

provided evidence that the appellant intentionally omitted or abandoned the subject matter of the present claims.

296. See also, Eggert, pp.18-19. Lastly, even though an inventor does not amend his application during prosecution, his arguments can prevent him from claiming subject matter in a reissue application that he disavowed during prosecution., i. e., "a surrender can occur through arguments alone." Hester Indus. Inc. v. Stein Inc., 142 F. 2d 1472, 1482, 46 USPQ 2d 1641, 1649 (Fed. Cir. 1998). See also, Eggert, pp. 27-28. Cf., Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 122 S. Ct. 1831, 1837, 62 USPQ 2d 1705 (2002) (amendments or arguments to advance prosecution can prevent the application of the doctrine of equivalents in an infringement action).

Stated otherwise, if an applicant amends his application to obtain a patent by adding or giving up a claim element for an invention, or if she or he argues patentability on the grounds that a claim for an invention either contains or does not contain an element, and the examiner allows the claim based on the amendment or argument, he or she cannot obtain that element or eliminate it in a reissue application, contrary to the position previously taken during prosecution. Once having taken the position to obtain allowance of the claim for the invention, the applicant cannot later go back on it.

With this in mind, it is apparent appellants have not attempted to recapture subject matter claimed during the prosecution of the reissue patent; they never submitted process claims for forming metal oxides from precursors. Appellants do not recapture subject matter with the present claims that they previously gave up by way of amendment or argument in the prosecution of the reissue patent.

THE EXAMINER'S ANSWER

Appellants will address the recapture issues raised in the order they appear in the Examiner's Answer. Page five of the Examiner's Answer, initially attempts to argue

the so-called Clement analysis⁷ applies to all the reissue claims, however ignores that Clement only bears on instances where an applicant distinguished prior art cited either under 35 U.S.C. §§ 102 or 103, and not rejections under 35 U.S.C. §112, the only rejection the examiner made in the reissue patent. If the Clement analysis has any bearing at all the examiner would have to apply it to the components of the present process claims 28-32. These claims, as noted before do not limit the process to tin oxide precursors, but rather metal oxide precursors and also broadens the accelerants.

The examiner never rejected the tin oxide precursor of the reissue patent or the accelerants, and appellants never amended the reissue claims or made arguments regarding the patentability of the tin oxide precursors or the accelerants either in response to a 35 U.S.C. § 112 rejection or a prior art rejection.

Furthermore, appellants never indicated in any way in the written description of the reissue patent or its prosecution that the metal oxide precursors or accelerants now included in the process claims did not comprise part of the invention, and the examiner does not now argue or point to anything that show appellants did this.

The tin oxide precursor and the accelerants in the claimed process amount to aspects unrelated to the rejection, and according to Clement, with reissue claims 28-32 broader in an aspect unrelated to the rejection (i.e., the metal oxide precursors and accelerants), the recapture rule does not bar claims 28-32. Clement, 45 USPQ 2d at 1165.

Clement, also does not apply to the process claims since appellants never presented process in the reissue application, and never indicated in any way in the

7. In re Clement, 131 F.2d 1464, 45 USPQ 2d 1161 (Fed. Cir. 1997)

written description of the reissue patent that they did not constitute part of the invention.

The amendments in the reissue patent directed toward composition claims do not carry over to the process claims in the present reissue application since these process claims comprise a statutory class of invention different than the composition claims. Different statutory classes of invention are separate inventions.

Studiengesellschaft Kohle mbH v. Northern Petrochemical Company, 784 F.2d 351, 228 U.S.P.Q. 837, 839 (Fed. Cir. 1986). They differ in that infringement of one type of claim doesn't carry any presumption of infringement of the other. Prosecution of the reissue patent composition claims therefore has no bearing on the process claims.

Page six of the Examiner's Answer cites Eggert to support his contention that the patentee is precluded from recapturing in reissue that which he earlier conceded was unpatentable and abandoned or surrendered. The examiner, however, has not pointed to anything in the prosecution of the reissue patent that shows appellants conceded the unpatentability of the presently claimed process claims for forming an oxide composition from metal oxide precursors, or that they abandoned or surrendered this part of the invention.

Also on page nine of the Examiner's Answer he argues that "[t]he decision not to appeal is an irrevocable admission of unpatentability" (citing Festo), and "[t]he recapture rule prevents a patentee from regaining rejected subject matter." (citations omitted). Appellants only reply that the examiner never had process claims that included the present accelerants, or metal oxide precursors before him in the reissue patent, and therefore did not reject them. The examiner also did not reject the tin oxide precursors or the accelerants in the reissue patent. Appellants therefore could not appeal issues

that pertained to these unclaimed and unrejected aspects of the invention, and the examiner cannot now imply that at one time he rejected claims to these aspects of the invention.

Page ten of the Examiner's Answer also argues that "[r]eissue does not give the patentee the right to prosecute de novo his original application." citing In re Weiler, 790 F. 2d 1576, 229 USPQ 673 (Fed. Cir. 1986). Appellants' reissue application does not prosecute original claims 1-28 of the reissue patent again by amending them, but only presents additional reissue claims to the process which enlarges the scope of the original patent. The reissue statute, 35 U.S.C. § 251, sanctions this.

The examiner goes on to argue at page 11 that reissue claims 28-32 do not recite the parameter of original claim 11, (implying the $R_mO_nSi_p$ silicon oxide precursor⁸), and further implies these claims fail to recite the tin oxide precursor of the reissue patent by broadening this class of compounds to metal oxide precursors. To the extent that the examiner suggests that appellants canceled subject matter pertaining to the tin oxide precursors or accelerants in the reissue claims, an examination of the prosecution of those claims shows that appellants never cancelled the tin oxide precursors or argued the scope of the tin oxide precursors or the accelerants in response to a rejection in order to advance the prosecution of these claims. The examiner cannot now say that appellants treatment of the tin oxide precursors in the prosecution of the reissue patent now bars them from claiming the metal oxide precursors, since all that appellant did in the earlier prosecution was to leave the original terms "tin oxide precursor" intact in the reissue claims which the

8. The examiner raises the same argument at page 7 of his Answer.

examiner never rejected nor objected to.

Similarly, appellants retained the original definition of the accelerants in claims 1-5, but amended claim 6 to broaden the triethyl phosphite accelerant to organic phosphites and borates having the formulas $(R''O)_3P$ and $(R''O)_3B$ even though the examiner never rejected the accelerants or raised an objection to them. He subsequently allowed the claims with both of these descriptions. As with the tin oxide precursors, to the extent that the examiner implies that appellants canceled subject matter pertaining to the accelerants in the reissue claims, an examination of the prosecution of those claims shows that appellants never cancelled the broad description of the accelerants or argued the scope of the accelerants in response to a rejection or objection in order to advance the prosecution of these claims. The examiner cannot now say that appellants' treatment of the accelerants in the reissue prosecution now bars them from claiming them in the manner set out in the reissue claims.

The examiner views the written description of the application as evidencing a specific intent not to claim subject matter not exhibiting the deposition rate of greater than about "350 Å/sec." implying that the process claims have to include the silicon oxide precursor of the formula $R_mO_nSi_p$. (Examiner's Answer, par. bridging pp.12-13). Granted, one aspect of the invention does focus on the deposition rate of greater than about 350 Å/sec. obtained when using the silicon oxide precursor of the formula $R_mO_nSi_p$, but the invention, as pointed out before in this Reply Brief, does not stop there. The "invention. . . [also relates to] producing an improved coating on glass, wherein the coated glass exhibits specific properties such as, e.g., controlled refractive

index, abrasion resistance, color enhancement, low emissivity, selective light filtration, and anti-iridescence on flat glass substrates.” (reissue patent col. 4, lines 13-18). These inventions are in addition to those of the composition claims that focus on obtaining improved coating speeds with the silicon oxide precursor of the formula $R_mO_nSi_p$.

The examiner then cites MPEP §1412.01 (B) which has no bearing on the present case, since it only pertains to instances where the applicants specifically state their invention does not pertain to a particular embodiment, and they subsequently attempt to claim that embodiment. Here, the examiner has not pointed to anything in the application where the appellants have stated or implied their invention does not pertain to the presently claimed process.

The examiner attempts to dismiss appellants’ reliance on In re Wesseler, 367 F. 2d 838, 847, 151 USPQ 339 (CCPA 1966) by arguing the court did not find recapture because they could not “distinguish whether the amendments made to secure patentability were due to the rejection under §112 (2) or the prior art such that the court could not determine which material had been actually surrendered.” (Examiner’s Answer, p. 9, second full par.) (emphasis added). The court, contrary to the examiner’s assertion, however, did make the determination that where the application was previously rejected under both 35 U.S.C. § 112 and 35 U.S.C. § 103, (Wesseler, 151 USPQ at 345) the case as it stood before them for decision was no longer rejected on prior art, but rather 35 U.S.C. § 112, noting “[h]ere, however, there is no objection to the appealed [reissue] claims based on prior art. We do not think the Statement in Shepard [Shepard v. Carrigan, 116 U.S. 593, 5976 S. Ct. 493, 495, 29 L. Ed. 723 (1886)]. . . is applicable here. Sheppard may be support for the rule that one who

deliberately adds a limitation to avoid the prior art cannot omit that limitation in reissue claims. . . but that is not the situation here.” (Wesseler, 151 USPQ at 345-46).

Because the applicants did not give up a part of their invention in response to a prior art rejection, but instead responded to the only remaining rejection under 35 U.S.C. § 112, the court found that broadening of the claims in reissue did not amount to a prohibited “recapture” of subject matter.

As to the examiner’s contention that the “court could not determine which material had been actually surrendered” appellants point out that the court specifically found the reissue claims omitted a limitation introduced in the prosecution of the parent application, i.e., an “offset ear” (Wesseler, 151 USPQ at 344, 1st full par.; 151 USPQ at 345, 2nd full par.), but nonetheless held that broadening the claims by this omission did not bar them under the recapture doctrine. (Wesseler, 151 USPQ at 346, 349).

The examiner in attempting to distinguish Wesseler, argues that appellants relied on that decision for the definition of “error” in the reissue statute, but case law subsequently changed that definition, citing In re Wadlinger, Kerr and Rosinski, 181 USPQ 826 (CCPA 1974) to support his position. Appellants point out, however, that even though Wadlinger addresses the use of the term “error” in the statute, it does not overrule or “eviscerate” (examiner’s Answer p. 9, first full par.) the underlying principle in Wesseler that allowed broadened claims in a reissue application where the application only stood rejected on grounds of insufficiency of disclosure, and not prior art. The court in Wesseler clearly considered this action on the part of the applicants amounted to addressing an “error” in the prosecution, and the Examiner has not shown where the Wadlinger court re-construed the concept of “error” in the reissue statute in

a way that runs counter the decision in Wesseler. The present case parallels Wesseler, which found no recapture also addresses the issue of alleged recapture where the examiner only rejected the original claims under 35 U.S.C. §112, and not prior art. Interestingly, the applicants in Wesseler, as in the present application, copied claims from an issued patent in order to provoke an interference. Wesseler 151 USPQ at 342.

CASE LAW SUPPORTS THE APPELLANTS' BROADENED REISSUE

Wesseler allows the appellants to file broadened reissue claims where the examiner has rejected the application under 35 U.S.C. §112 as discussed above. Appellants never presented the presently claimed process using metal oxide precursors and accelerants in the reissue application, and accordingly never introduced arguments or amendments to advance their prosecution in that application.

Case law makes clear that the recapture doctrine applies only to amendments or arguments that address patentability issues advanced during the course of prosecution of an application in order to overcome a rejection. The presently claimed process employing metal oxide precursors, were not rejected, nor could they, since appellants did not present those claims in the reissue patent. Where an appellant has not urged patentability in either way, i.e., by amendment or argument, recapture does not exist. Ball Corp. v. United States, 729 F.2d 1429, 221 U.S.P.Q. 289 (Fed. Cir. 1984); In re Wallingham, 282 F.2d, 353, 127 U.S.P.Q. 211-215 (C.C.P.A. 1960); In re Wadlinger et al., 496 F.2d 1200, 181 U.S.P.Q. 826, 830, 832 (C.C.P.A. 1974). Also, "where claims have not been previously cancelled, relative claim scope is not available to illuminate the alleged error" Ball, 729 F.2d at 1434, 221 U.S.P.Q. at 295, and fn. 19 (Emphasis

added).

The process claims on appeal differ from the composition claims of the reissue patent, as different classes of invention as held in Studiengesellschaft Kohle mbH. As the court stated in Wadlinger, "[a]s for obtaining claims on reissue that are different,"⁹ no prohibition arises merely because of the language of the reissue statute. Still apropos and basic is our statement in Wesseler, 151 USPQ at 348: '[w]e think the term 'error,' . . . is to be interpreted in light of the Supreme Court decisions favoring the liberal construction of reissue statutes in order to secure to inventors protection for what they actually invented.'" Wadlinger, 181 USPQ at 832 (Emphasis added).

The Court of Appeals for the Federal Circuit in In re Doyle, 293 F. 3d, 1355, 63 U.S.P.Q. 2d 1161 (Fed. Cir. 2002) held that failure to prosecute restricted species or subgeneric claims in a divisional application did not prevent the inventor from reissuing the base patent to claim the invention as a genus that dominated the abandoned restricted species or subgeneric claims. The applicant had not presented those generic claims in the underlying patent, and the Board of Patent Appeals and Interferences correctly ruled that the recapture doctrine did not apply, rejecting the claims in stead on the Orita doctrine.¹⁰ The Court of Appeals for the Federal Circuit , however rejected this argument. This case, as in Wadlinger, also stands for the proposition that an applicant can claim different inventions in reissue than those of the original patent.

9. In Wadlinger, the appellants claimed a zeolite and the method of making it in the original patent. On reissue they claimed a different invention, viz, a method for using zeolite beta as a catalyst for the cracking of hydrocarbons. Wadlinger, 181 USPQ at 827.

10. In re Orita, 550 F.2d 1280, 193 USPQ 145 (CCPA 1977) holding that an applicant could not prosecute restricted claims in a reissue application where the applicant never filed a separate application for those claims after the restriction requirement.

THE REJECTION UNDER 35 U.S.C. § 103(A) AND TRAVERSE

Appellants traverse the rejection under 35 U.S.C. § 1093 (a) for the same reasons set forth in their Brief in Chief at pages 5-7 and incorporate those reasons by reference in this Reply Brief.

Appellants previously pointed out that rejected claims 28-32 require an accelerant based on either an organic phosphite, organic borate or water which the Gordon reference neither teaches nor suggests, and that Gordon teaches the undesirability of water, cautioning against it in example 2, which shows water causes an undesirable reaction with a "metal oxide precursor," viz., an organoaluminum compound (aluminum-2, 4-pentanedionate). The adverse results clearly illustrates the undesirability of using water with metal oxide precursors, and as such provides no motivation for the skilled artisan to combine the teachings of Gordon with Langendijk. Cf., M.P.E.P. Section 2143.01, Rev. 1, Feb. 2000, pp. 2100-98 to 2100-99 and cases cited therein. Gordon, in fact, teaches away from combining these references.

The examiner, however, argues that "Table E, [of Gordon]. . . explicitly includes H₂O as a useful oxygen source (accelerant)." (Examiner's Answer, p. 4, first full par., final sentence.) But, Table E does not describe the use of water in a CVD process with a metal oxide precursor, but rather a silicon oxide precursor, and as pointed out in appellants' Brief in chief, silicon is not a metal. (Brief in Chief, p. 6, first full par. and f.n. 1). Given these data, the skilled artisan has a prior art statement that water does not work with a metal oxide precursor (aluminum-2,4-pentanedienoate) and water does work with a silicon oxide precursor. Knowing that silicon is not a metal, why would the skilled artisan then presume that the teaching of water with a non-metal would mean that water would also work with a metal, when the prior art also informs her or him just

the opposite, namely water does not work with a metal?

THE CLAIMS DO NOT STAND OR FALL TOGETHER

The claims do not stand or fall together for the reasons appellants have given in their Brief in Chief at pp. 19-20, contrary to the arguments of the examiner on page 13, first full paragraph, of the Examiner's Answer.

OFFER IN THE ALTERNATIVE TO DEDICATE CLAIMS TO THE PUBLIC

If, despite the above arguments, the Board maintains that claims 28-32 can be rejected on the grounds that appellants have attempted to recapture subject matter that should have entered into the public domain by being previously abandoned in the prosecution of the reissue patent, then again appellants, in the alternative traverse the "recapture" rejection by offering to dedicate back to the public, claims 28-32 of the reissued patent on the terms and conditions set out on pp. 20-22 in their Brief in Chief.

Conclusions

Appellants request the Board to overrule the Examiner in all respects, and remand the application to the Examiner for issuance of a Notice of Allowance. If the Board overrules the Examiner appellants request that the Board indicate if they base their action upon appellants' arguments, or upon appellants' alternative offer to dedicate claims 28-32 to the public as set out at pp. 20-22 in their Brief in Chief.

Respectfully submitted,

The Law Offices of Robert J. Eichelburg

By: Robert J. Eichelburg
Robert J. Eichelburg, Reg. No 23,057

Dated: October 15, 2003

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Services under 37 C.F.R. § 1.8 on the date indicated below and is addressed to the Commissioner for Patents, P.O. BOX 1450, Alexandria, Virginia 22313 -1450

By: Robert J. Eichelburg
Robert J. Eichelburg, Reg. No 23,057

Dated: October 15, 2003